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Docket No.: A3156.0022/PO22

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mitsuhiro Ono

Application No.: 09/873,649

Art Unit: N/A

Filed: June 4, 2001

Examiner: Not Yet Assigned

For: INTERGRATED CIRCUIT FOR MODEM

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON
FAILURE TO RECEIVE AN EX PARTE QUAYLE ACTION**

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2011 South Clark Place
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Crystal Plaza Two, Lobby, Room 1B03
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Technology Center 2100

Dear Sir:

It is respectfully requested that the Notice of Abandonment mailed March 31, 2004 be withdrawn and the Ex Parte Quayle Action originally mailed September 23, 2003, be remailed and the time to respond thereto be restarted.

This Petition is being submitted on the grounds that the original Ex Parte Quayle Action was never received.

An Ex Parte Quayle Action was mailed in the above-identified patent application on September 23, 2003 to the office of Ostrolenk Faber Gerb & Soffen ("Ostrolenk"). However, Applicant's representative never received this Ex Parte

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Quayle Action and was therefore unaware that a response was due. Applicant's representative was a partner at Ostrolenk. Applicant's representative joined Dickstein Shapiro Morin & Oshinsky, LLP ("Dickstein") in January 2002. Applicant's representative prepared a change of correspondence in this matter on or about February 6, 2002, so that mail would be sent to the New York office of Dickstein. Applicant became aware of the Ex Parte Quayle Action when the Examiner contacted Applicant's attorney regarding the failure to respond to the outstanding Ex Parte Quayle Action.

M.P.E.P. § 711.03(c)(II) provides that where Applicant's Petition to Withdraw a Holding of Abandonment is adequately supported, the Office may grant the Petition and re-mail the Office action. Applicant's Petition will be adequately supported under § 711.03(c)(II) where Applicant provides (1) "a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received"; and (2) a "copy of the docket record where the non-received Office communication would have been entered had it been received and docketed." The copy of the docket record must be attached to and referenced in the practitioner's statement.

Applicant files herewith a Declaration by practitioner Steven I. Weisburd (Reg. No. 27,409) stating that the Ex Parte Quayle Action, mailed September 23, 2003, was not received by Ostrolenk or Dickstein and that had the Ex Parte Quayle Action been received by anyone in practitioner's law firm, it would have been entered in the law firm's docketing records. Mr. Weisburd's Declaration further

attests that a search of the file jacket and the docket records indicates that the Ex Parte Quayle Action was not received. Further, when the file was transferred to Dickstein, any outstanding responses would have been entered in the Dickstein docket.

Further, Mr. Weisburd's Declaration sets forth the standard business practice with regard to Office Actions and other correspondence from the PTO. Mr. Weisburd transferred his practice from the Ostrolenk firm to Dickstein on January 2, 2002. Subsequent to that date, change of correspondence address communications were filed in the cases Mr. Weisburd transferred to Dickstein. Any mail received for Mr. Weisburd at Ostrolenk was picked up by an employee of Dickstein and brought to the Dickstein docketing department. The Ostrolenk law firm has not moved and all mail received by Ostrolenk for Mr. Weisburd is held until it is picked up.

Applicant files herewith a Supplemental Declaration of David Andres whose responsibilities include picking up the mail from Ostrolenk and delivering it to the docketing department at Dickstein. Mr. Andres attests that if the Ex Parte Quayle Action had been sent to Ostrolenk, he would have picked it up and brought it to the Dickstein docketing department.

The Dickstein docket record where the non-received Ex Parte Quayle Action would have been entered, had it been received and docketed or present in the file jacket, is attached as Exhibit C to Mr. Weisburd's Declaration. Specifically, Exhibit B shows the Dickstein docket records for every matter docketed for October 23, 2003 (one month after the date of mailing of the Ex Parte Quayle Action), and

March 23, 2004 (the deadline for a responding to the Ex Parte Quayle Action). Applicant files herewith a copy of the docket record for October 23, 2003, and March 23, 2004, for the Examiner's convenience. A review of these docketing records shows that no deadlines for Docket No. A3156.0022 were docketed for either October 23, 2003 or March 23, 2004.

Applicant also files herewith a Supplemental Declaration of Henrietta Marron, who maintains the docket at Dickstein, attesting that if anyone in the docketing department at Dickstein had received the Ex Parte Quayle Action mailed March 23, 2003, or if it was hand carried to Dickstein from Ostrolenk, the Ex Parte Quayle Action would have been entered into the law firm's docket records. The fact that the Ex Parte Quayle Action does not appear on Dickstein's docket records indicates that Dickstein did not receive the Ex Parte Quayle Action and that the Ex Parte Quayle Action was not present in the file jacket.

For the foregoing reasons, Applicant respectfully requests that this Petition be granted and that the Ex Parte Quayle Action be re-mailed and the time to respond thereto be restarted.

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The Patent Office is hereby authorized to charge our credit card for the \$130.00 petition fee. PTO Form 2038 is enclosed.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-2215.

Dated: April 8, 2004

Respectfully submitted,

By 

Steven I. Weisburd

Registration No.: 27,409

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IRB/mgs
Attachments